REMARKS

Claims 1, 4-7, 9-12, 15-18, and 20-21 stand rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. Applicants request that claims 1, 9, and 12 be amended to cure an informality.

Response to rejections of claims under 35 U.S.C. § 112, first paragraph.

Claims 1, 4-7, 9-12, 15-18, and 20-21 stand rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. Applicants respectfully traverse this rejection.

The Examiner asserts that no portion of the specification teaches that a tape storage medium is identified as full "...such that no additional data may stored to the tape storage medium..." Claim 1. Applicants respectfully disagree.

Applicants submit that the Examiner seems to be maintaining the rejection strictly on the grounds that word-for-word support is not present in the specification to explain that no additional data may be stored on a full tape. Applicants submit that one of skill in the art reading the specification would readily grasp the concepts taught so as to make and use the invention set forth in amended claims 1, 9, and 12. Applicants submit that such a word-for-word support requirement is not the legal standard and is improper.

The words of the claim must be given their "plain meaning" unless they are defined in the specification. MPEP §2111.01. "[The] meaning of words used in a claim is not construed in a "lexicographical vacuum, but in the context of the specification and drawings." *Toro Co. v.*

White Consolidated Industries Inc., 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999). MPEP §2106. According to the Manual of Patent Examining Procedure, "Office personnel must rely on the applicant's disclosure to properly determine the meaning of terms used in the claims." MPEP § 2106. *Markman v. Westview Instruments*, 52 F.3d 967, 980, 34 USPQ2d 1321, 1330 (Fed. Cir.) (*en banc*), *aff 'd*, U.S. , 116 S. Ct. 1384 (1996).

"By disclosing in a patent application a device that inherently performs a function or has a property, operates according to a theory or has an advantage, a patent application necessarily discloses that function, theory or advantage, even though it says nothing explicit concerning it. The application may later be amended to recite the function, theory or advantage without introducing prohibited new matter. *In re Reynolds*, 443 F.2d 384, 170 USPQ 94 (CCPA 1971); *In re Smythe*, 480 F. 2d 1376, 178 USPQ 279 (CCPA 1973). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." MPEP §2163.07(a).

Applicants submit that the limitation "...such that no additional data may stored to the tape storage medium..." is inherent from the specification as the specification makes it clear that that no additional data may be stored on a "full" tape. See page 16, ¶ 64. To construe the specification otherwise defeats one aspect of the present invention, reducing capacity to increase performance. Applicants therefore submit that the written description requirement of 35 U.S.C. § 112, first paragraph is satisfied as the limitation "...such that no additional data may stored to the tape storage medium..." is inherently supported by the specification.

Applicants assert that claims 1, 9, and 12 are allowable. Applicants further submit that claims 4-7, 10, 11, 14-18, and 21 are allowable as depending from allowable claims.

Should additional information be required regarding the traversal of the rejections of the claims enumerated above, Examiner is respectfully asked to notify Applicants of such need. If any impediments to the prompt allowance of the claims can be resolved by a telephone conversation, the Examiner is respectfully requested to contact the undersigned.

Respectfully submitted,

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